

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-2 have been amended. New claims 24-25 have been added. Claims 10-17 and 20-23 have been cancelled. Claims 1-9, 18-19, and 24-25 are pending and under consideration. This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding.

Entry of Amendment under 37 C.F.R. § 1.116

The Applicants request entry of this Rule 116 Response because the amendment does not significantly alter the scope of the claims and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures (M.P.E.P.) sets forth in Section 714.12 that “any amendment that would place the case either in condition for allowance or in better form for appeal may be entered.” Moreover, Section 714.13 sets forth that “the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.” The M.P.E.P. further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Rejections under 35 U.S.C. § 103

In the Office Action, at pages 2-6, claims 1-9 and 19-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nishibori et al. (U.S. Patent No. 5,323,971) in view of Gordon (UK Patent Application GB 2 121 535 A).

Neither Nishibori et al. nor Gordon discuss or suggest:

the peeling is performed within a predetermined time such that the pulverized pieces maintain a particle diameter of at least a predetermined size and the coating film removal ratio of the peeling does not reach one hundred percent,

as recited in amended claim 1. In other words, the invention of claim 1 provides for peeling the pulverized pieces within a predetermined time such that the pulverized pieces maintain a particle diameter of at least a predetermined size and the coating film removal ratio of the peeling does not reach one hundred percent. In this manner, the particle diameter and the removal ratio are

controlled by the peeling time. By providing for peeling to take place within a predetermined time, the method of claim 1 allows for a short enough time to be set, such that the pulverized pieces are not completely peeled. Nishibori et al. provides for completely compressing the crushed pieces during the peeling such that they are finely pulverized. In contrast, Nishibori et al. does not limit the peeling to being within a predetermined time such that the pieces maintain a predetermined diameter. While Nishibori et al. does provide that the resin material may not be completely cleared of the resin film, the resin material is so finely pulverized that it would be difficult for a sensor to accurately detect the presence of the resin film. Clearly, the object of Nishibori et al. is complete peeling, and such is the reason that Nishibori et al. is silent regarding sensing and determining the presence of resin film for each individual pulverized piece after the peeling, as is conceded by the Examiner. Also, Gordon clearly fails to make up for this deficiency in Nishibori et al.

Further, it would not have been obvious to have combined the process of Nishibori et al. with the detector of Gordon in order to focus the practicing of the method of separating the skin and resin by detecting the object with the desired skin and resin characteristics. As discussed above, Nishibori et al. is concerned with complete peeling and, to that end, provides for pulverizing the resin material pieces into fine particles without regard for particle size. As such, one of ordinary skill in the art would not contemplate separating the remaining pieces of Nishibori et al. based on the presence of resin film, because the remaining pieces have been peeled such that little or no resin film actually remains. Therefore, the Examiner's motivations for combining the references are not proper. Also, there is no adequate motivation to combine the process of Nishibori et al. with the detector of Gordon without having to rely on the Applicants' own disclosure and, even if Nishibori et al. were combined with Gordon, the invention of claim 1 would not result. Applicants respectfully request that the Examiner directly address the motivation argument put forth above.

Since neither Nishibori et al. nor Gordon discuss or suggest:

the peeling is performed within a predetermined time such that the pulverized pieces maintain a particle diameter of at least a predetermined size and the coating film removal ratio of the peeling does not reach one hundred percent,

as recited in amended claim 1, and there is no adequate motivation to combine the references, claim 1 patentably distinguishes over the references relied upon. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 3-9 depend either directly or indirectly from claim 1, and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 3-9, 20, and 22 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

Neither Nishibori et al. nor Gordon discuss or suggest:

the peeling is performed within a predetermined time such that the pulverized pieces maintain a particle diameter of at least a predetermined size and the coating film removal ratio of the peeling does not reach one hundred percent,

as recited in amended claim 2, and there is no adequate motivation to combine the references, so that claim 2 patentably distinguishes over the references relied upon. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 18-19 depend either directly or indirectly from claim 2, and include all the features of claim 2, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 18-19, 21, and 22 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

Claims 20-23 have been cancelled. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

New Claims

New dependent claims 24-25 have been added. As discussed above, claim 1 patentably distinguishes over the references relied upon. Claims 24-25 depend directly from independent claim 1, and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Thus, it is submitted that claims 24-25 are in a condition suitable for allowance.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.


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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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